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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,880	10/12/2006	John Frankhuisen	784-107 (177490)	9171
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EXAMINER WOOD, ELLEN S				
ART UNIT 1794		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ip@akerman.com

Office Action Summary

Application No.

10/552,880

Applicant(s)

FRANKHUISEN, JOHN

Examiner

ELLEN S. WOOD

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SI/200)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 08/31/2009

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regards to claim 24, the applicant claims **"wherein the outer layer is paper"**. The claim is dependent from claim 18 which is dependent from claim 16. Claim 16 claims an outermost layer but does not describe an outer layer. Does the "outer layer" comprise a multi-layer laminate? Where is the outer layer positioned within the laminate?

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 4-11 and 15-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Samonides (WO 91/16025).

In regards to claims 1 and 23, Samonides discloses a pre-printed label. The label consist of a carrier sheet (outer layer), may be a white kraft paper (pg. 13 ¶1). Thus, the

outer layer has an opacity. A transparent face sheet (under layer) is extruded onto the carrier sheet (pg. 13 ¶3). The face sheet has been described as transparent but the film may be opaque (pgs. 14-15 ¶3). It would be inherent that when a paper layer is exposed to moisture or liquid the opacity would reduce, however when a polyolefin is exposed to moisture or liquid the opacity would retain, because paper absorbs moisture or liquid, wherein polyolefin materials repel moisture or liquid.

In regards to claims 2, Samonides discloses that the face sheet is adhered to the carrier sheet and the face sheet being a film of plastics (pg. 13 ¶3).

In regards to claim 4, Samonides discloses that the carrier sheet is secured to the face sheet by a permanent adhesive (pg. 13 ¶3).

In regards to claim 5, Samonides discloses that the face sheet is a stable laminate base (pg. 4 ¶1).

In regards to claims 6-7, Samonides discloses that the first or bottom surface of the pressure-sensitive adhesive layer may be adhesively affixed to another surface, such as the surface of a container or the like (pg. 4 ¶4). The examiner considers this the innermost surface.

In regards to the claim 8, Samonides discloses a label attached to the outer surface of a container by a glue which is applied to the label when wet and allowed to dry when in situ on the container (pg. 5 ¶2).

In regards to claims 9 and 22, Samonides discloses that the container is a clear bottle (pg. 1 ¶2).

In regards to claims 10-11, Samonides discloses that the face sheet is formed of a polyester resin, or polypropylene, or polyethylene (pg. 13 ¶3).

In regards to claim 15, Samonides discloses that the face sheet is extruded on top of the printing, and the composite is then pressed between form rolls (pg. 13 ¶3). The outer layer is being joined to the under layer onto a sheet of extruded plastics material.

In regards to claims 16-17, Samonides discloses an outermost label wherein a pressure sensitive adhesive layer has printed label indicia which is then covered by a thermoplastic protective cover (pg. 4 ¶1). The pressure-sensitive adhesive layer is applied to smooth surface, such as a bottle (pg. 4 ¶1), thus, an innermost layer that is coupled between the outermost layer and the bottle. The protective cover and the adhesive may be an opaque material (pg. 15 ¶1).

In regards to claim 18, Samonides discloses that the pressure-sensitive adhesive is preferably a water-based, acrylic adhesive and may be colorless or tinted (pg. 10 ¶4). The formula for the acrylic adhesive includes acrylate polymer (pg. 10 ¶4), thus a plastics material.

In regards to claims 19-20, Samonides discloses the laminate formed through extrusion (pg. 14), which is a water insoluble means and fusion of plastics material.

In regards to claim 21, Samonides discloses that the label has a pressure-sensitive adhesive layer, preferably a water-based acrylic adhesive (pg. 3 ¶3). Printed label indicia is applied to the pressure-sensitive adhesive layer and a thermoplastic protective cover layer covers the printed indicia and is irremovably affixed to the second

or top surface of the pressure-sensitive adhesive layer, which is the surface carrying the printed label indicia (pg. 4 ¶ 1). The first or bottom surface of the pressure-sensitive adhesive layer may be adhesively affixed to another surface, such as the surface of a container or the like, and the printed indicia will be visible (pg. 4 ¶ 1).

In regards to claim 24, Samonides discloses a carrier sheet 4 that consists of a white kraft paper (pg. 13 ¶1). This is considered an outer layer of paper (fig. 2).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Samonides (WO 91/16025).

Samonides discloses the label of laminate construction as previously discussed. Smith is silent with regards the level of opaqueness of the polypropylene plastic.

Samonides discloses that a transparent face sheet (under layer) is extruded onto the carrier sheet (pg. 13 ¶3). The face sheet has been described as transparent but the film may be opaque (pgs. 14-15 ¶3) so that the label indicia which has been printed on the adhesive layer at the interface with the face sheet is visible through the adhesive and through the underside of the label (pg. 15 ¶3). This is desirable where the label is applied to a clear bottle (pg. 15 ¶3).

It would be obvious to one of ordinary skill in the art to use an appropriate level of opaqueness of the white face sheet when applying the label to a glass bottle, because the white face sheet and level of opaqueness provides the printed indicia to appear when the label is wet.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-6, 10, 15 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Akio (JP 10-180970).

In regards to claim 1, Akio discloses a opaque layered product [0005]. The layered product is considered a laminate construction. The layered product comprises a surface layer of pulp paper (outer layer) and a opaque support layer (under layer)[0005]. The opaque support layer is formed from opaque vegetable pup paper, an opaque plastic film, a metallic film, etc. [0005]. The pulp paper is laminated to the opaque film [0022]. Thus, the under layer is attached to the outer layer. A color picture is recorded on the pulp paper [0023]. The laminate of Akio is considered a label, because the broadest reasonable interpretation would define a label as a printed surface.

The limitation in claim 1 of, "wherein the opacity of the outer layer material reduces after the outer layer is exposed to moisture or liquid" is functional language of just the outer layer material and does not give rise to the function of the label. Thus, if the prior art structure is capable of performing the function of the label then it meets the claim.

In regards to claim 2, Akio discloses that the opaque support layer is formed from opaque vegetable pup paper, an opaque plastic film, a metallic film, etc. [0005].

In regards to claim 3, Akio discloses that the PET film is white [0022].

In regards to claim 4, Akio discloses that the opaque base material is adhered to the pup paper through a permanent adhesive [0012].

In regards to claim 5, Akio discloses a base material [0005]. This is considered a stable laminate base. Additionally, it should be noted that it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

In regards to claim 6, Akio discloses a base material adhered to a surface layer [0012]. Thus, the base material is adapted to adhere to the surface layer. Additionally, it should be noted that it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

In regards to claim 10, Akio discloses that the opaque base material can be a plastic film or polyester, polyethylene and polypropylene [0005].

In regards to claim 15, Akio discloses that the outer layer is joined to the under layer by being applied directly onto a sheet of extruded plastics material [0012].

In regards to claim 23, Akio discloses that the outermost layer is paper [0005].

Response to Arguments

9. Applicant's arguments filed 11/24/2009 have been fully considered but they are not persuasive.
10. The objection to the specification has been removed.
11. The objection to the drawings
12. The applicant argues that Samonides makes no reference to any change in the opacity of any of the labels upon exposure to moisture which is required in the present claims.
13. In response, it would be inherent that when a paper layer is exposed to moisture or liquid the opacity would reduce, however when a polyolefin is exposed to moisture or liquid the opacity would retain, because paper absorbs moisture or liquid, wherein polyolefin materials repel moisture or liquid. The applicant does not provide any evidence to the contrary. Also, the claim states that the "outer layer material reduces after the outer layer is exposed to moisture or liquid". The claim language is directed towards the function of the outer layer material not the function of the label of laminate

construction. Thus, the opacity of the outer layer material reduces after exposure to moisture or liquid regardless dependent on the material that is used for that the layer not the overall construction of the label.

14. The applicant argues that the labels of the present claims retain the look and feel of a traditional paper label, but have readability advantages over the traditional labels. This is clearly not taught or suggested by Samonides, and the present claims are thus believed to define patentable subject matter.

15. In response, the invention of Samonides does not have to solve the same problems that the applicant aims to solve through the claimed invention. The structure of Samonides anticipates the claimed subject matter of the applicant's, thus Samonides fully anticipates the applicant's claimed invention.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELLEN S. WOOD whose telephone number is (571)270-3450. The examiner can normally be reached on M-F 730-5 with every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571)272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ELLEN S WOOD/
Examiner, Art Unit 1794

/Rena L. Dye/
Supervisory Patent Examiner, Art Unit 1794

